



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,954	10/15/2003	Mitch Fredrick Singer	113748-4835US	8818
27189 7590 01/25/2010 PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101				
EXAMINER KRISHNAN, VIVEK V				
ART UNIT 2445		PAPER NUMBER		
NOTIFICATION DATE 01/25/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@procopio.com

PTONotifications@procopio.com

Office Action Summary

Application No.

10/686,954

Applicant(s)

SINGER ET AL.

Examiner

Vivek Krishnan

Art Unit

2445

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-18, 20-26, 28, 29, 31 and 46-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-18, 20-26, 28, 29, 31 and 46-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :08/27/2009; 10/22/2009; 12/24/2009.

DETAILED ACTION

This action is responsive to the Amendment/Arguments filed on September 29, 2009. Claims 1, 18, 26, 29, and 46 have been amended. Claims 2, 19, 27, 30, 32-45, and 51-58 have been cancelled. Claims 1, 3-18, 20-26, 28, 29, 31, and 46-50 are pending.

Response to Arguments

1. Applicant's arguments with respect to the Election/Restriction have been fully considered. Claims 32-45 and 51-58 are withdrawn and furthermore cancelled from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 29, 2009.
2. Applicant's arguments with respect to the Oath/Declaration have been fully considered and are persuasive in view of the supplemental Oath/Declaration filed. The objection to the Oath/Declaration has been withdrawn.
3. Applicant's arguments filed with respect to the Information Disclosure Statement have been fully considered but they are not persuasive. In view of the vast number of references cited in the case, in addition to the new information disclosure statements filed since the last outstanding Office Action, Examiner maintains the position that by initialing each of the cited references on the accompanying 1449 forms, the examiner is merely acknowledging the

submission of the cited references and merely indicating that only a cursory review is made of the cited references.

4. Applicant's arguments filed with respect to Claim Rejections under 35 U.S.C. 102(e) have been fully considered but they are not persuasive.

As to Applicant's arguments with respect to Claims 1-6, 8, 9, 18-21, 26-30, and 46-49:

a. Applicant argues that although Steenkamp states that licenses for distribution to a content destination are created and access to the content may be limited through simple access control, Steenkamp does not disclose or suggest granting licenses for content data bound to the hub network only to members of the hub network.

Examiner respectfully disagrees. It is clear from Steenkamp, paragraphs 68, 92-98, and 102, that licenses are granted (issued) only to clients who have been added as members (subscribers) of the digital rights network. Hence, Applicant's arguments are not persuasive.

5. Applicant's arguments filed with respect to Claim Rejections under 35 U.S.C. 103(a) have been fully considered but, in view of Examiner's arguments presented herein, they are not persuasive.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-6, 8, 9, 18, 20, 21, 26, 28, 29, and 46-49 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0168184 to Steenkamp et al. (hereinafter "Steenkamp").

8. As to Claim 1, Steenkamp discloses a method of adding a client as a member of a hub network, comprising:

detecting a client connected to a server in a hub network (Steenkamp; paragraphs 60 and 65; request);

authenticating said client (Steenkamp; paragraphs 60 and 65; authentication);

authorizing said client (Steenkamp; paragraphs 60 and 65; authorization); and

adding said client as a member in said hub network (Steenkamp; paragraphs 60 and 68; subscribed/registered); and

wherein the server provides a license for content data bound to said hub network only to members of said hub network (Steenkamp; paragraph 68, 98, and 102; licenses are granted (issued) only to clients who have been added as members (subscribers) of the digital rights network).

9. As to Claim 3, Steenkamp discloses the method of claim 1, further comprising receiving an add request indicating said client (Steenkamp; paragraph 60; request).

10. As to Claim 4, Steenkamp discloses the method of claim 3, wherein said add request is received from said client (Steenkamp; paragraph 60; request).

11. As to Claim 5, Steenkamp discloses the method of claim 1, further comprising connecting said client to said server (Steenkamp; paragraphs 60 and 65).

12. As to Claim 6, Steenkamp discloses the method of claim 1, wherein detecting said client includes receiving a connection notification from said client (Steenkamp; paragraph 60).

13. As to Claim 8, Steenkamp discloses the method of claim 1, wherein authenticating said client includes sending an identification request to said client, said identification request requests information from said client identifying said client (Steenkamp; paragraph 119).

14. As to Claim 9, Steenkamp discloses the method of claim 1, wherein authorizing said client includes sending a local environment confirmation request to said client (Steenkamp; paragraphs 99, 201).

15. As to Claim 18, Steenkamp discloses a method of adding a client as a member of a hub network, comprising:

sending a connection notification from a client to a server in a hub network (Steenkamp; paragraphs 95-96; request);

sending identification information from said client to said server (Steenkamp; paragraphs 84, 95, 274-282; userid); and

receiving an add confirmation at said client from said server; wherein said add confirmation indicates said client has been added as a member in said hub network (Steenkamp; paragraphs 84, 95, 274-282, 299; get subscriber confirmation indicating user account); and

wherein the server provides a license for content data bound to said hub network only to members of said hub network (Steenkamp; paragraph 68, 98, and 102; licenses are granted (issued) only to clients who have been added as members (subscribers) of the digital rights network).

16. As to Claim 20, Steenkamp discloses the method of claim 18, further comprising sending an add request indicating said client from said client to said server (Steenkamp; paragraph 98).

17. As to Claim 21, Steenkamp discloses the method of claim 18, further comprising connecting said client to said server (Steenkamp; Figure 2).

18. As to Claim 26, Steenkamp discloses a method of adding a client as a member of a hub network, comprising:

authenticating a client through an intermediary device connected to a server in a hub network (Steenkamp; paragraphs 60, 65, 341; authentication via proxy);

authorizing said client through said intermediary device (Steenkamp; paragraphs 60, 65, 341; authorization via proxy); and

adding said client as a member in said hub network through said intermediary device; wherein said client is not connected to said server (Steenkamp; Figure 2, paragraphs 60 and 68; subscribed/registered).

wherein the server provides a license for content data bound to said hub network only to members of said hub network (Steenkamp; paragraph 68, 98, and 102; licenses are granted (issued) only to clients who have been added as members (subscribers) of the digital rights network).

19. As to Claim 29, Steenkamp discloses a method of adding a client as a member of a hub network, comprising:

sending a connection notification from a client to a server in a hub network through an intermediary device connected to said server (Steenkamp; paragraphs 95-96; request);

sending identification information from said client to said server through said intermediary device (Steenkamp; paragraphs 84, 95, 274-282; userid); and

receiving an add confirmation at said client from said server through said intermediary device; wherein said add confirmation indicates said client has been added as a member in said hub network (Steenkamp; paragraphs 84, 95, 274-282, 299; get subscriber confirmation indicating user account);

wherein the server provides a license for content data bound to said hub network only to members of said hub network (Steenkamp; paragraph 68, 98, and 102; licenses are granted

(issued) only to clients who have been added as members (subscribers) of the digital rights network).

20. As to Claim 46, Steenkamp discloses a method of reconnecting a client to a hub network, comprising: detecting a client connected to a hub network (Steenkamp; paragraphs 60 and 65; request); authenticating said client as a member of said hub network (Steenkamp; paragraphs 60 and 65; authentication); authorizing said client (Steenkamp; paragraphs 60 and 65; authorization); and wherein the server provides a license for content data bound to said hub network only to members of said hub network (Steenkamp; paragraph 68, 98, and 102; licenses are granted (issued) only to clients who have been added as members (subscribers) of the digital rights network).

21. As to Claim 47, Steenkamp discloses the method of claim 46, further comprising refreshing one or more licenses stored on said client (Steenkamp; paragraph 98; licenses).

22. As to Claim 48, Steenkamp discloses the method of claim 46, wherein authenticating said client includes sending an identification request to said client, said identification request requests information from said client identifying said client (Steenkamp; paragraph 119).

23. As to Claim 49, Steenkamp discloses the method of claim 46, wherein authorizing said client includes sending a local environment confirmation request to said client, and said local environment is a limited area defined relative to said server (Steenkamp; paragraphs 99, 201).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claim 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steenkamp, as applied to Claims 1 and 18 above, and further in view of U.S. Patent Application Publication No. 2005/0273608 to Kamperman (hereinafter "Kamperman").

26. As to Claim 7, Steenkamp discloses the method of claim 1. Steenkamp further discloses that a [...] device will not decrypt locked content data without a license that is bound to a hub network of which the [...] device is a member (Steenkamp; paragraph 98).

Steenkamp does not explicitly disclose, however Kamperman discloses authenticating said client includes sending a compliance confirmation request to said client, said compliance confirmation request requests information from said client to confirm that said client is a compliant device (Kamperman; paragraphs 5, 6, 29-31; authentication includes device compliance).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authentication, as disclosed by Steenkamp, to include compliance

confirmation, as disclosed by Kamperman, in order to provide enhanced methods of authentication in a DRM network.

27. As to Claim 22, Steenkamp discloses the method of claim 18. Steenkamp further discloses that a [...] device will not decrypt locked content data without a license that is bound to a hub network of which the [...] device is a member (Steenkamp; paragraph 98).

Steenkamp does not explicitly disclose, however Kamperman discloses sending compliance information from said client to said server; wherein said compliance information indicates that said client is a compliant device (Kamperman; paragraphs 5, 6, 29-31; authentication includes device compliance).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authentication, as disclosed by Steenkamp, to include compliance confirmation, as disclosed by Kamperman, in order to provide enhanced methods of authentication in a DRM network.

28. Claim 10, 23, 28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steenkamp, as applied to Claims 9, 18, 26, and 29 above, and further in view of U.S. Patent Application Publication No. 2003/0167392 to Fransdonk (hereinafter "Fransdonk").

29. As to Claim 10, Steenkamp discloses the method of claim 9. Steenkamp does not explicitly disclose, however Fransdonk discloses said local environment confirmation request

requests information from said client indicating whether said client in a local environment of said server, and said local environment is a limited area defined relative to said server (Fransdonk; paragraphs 368-371).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the client/server, as disclosed by Steenkamp, to include a local environment, as disclosed by Fransdonk, in order to provide geographic access criteria in DRM networks.

30. As to Claim 23, Steenkamp discloses the method of claim 18. Steenkamp does not explicitly disclose, however Fransdonk discloses sending authorization information from said client to said server; wherein said authorization information indicates said client is in a local environment of said server, and said local environment is a limited area defined relative to said server (Fransdonk; paragraphs 368-371).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the client/server, as disclosed by Steenkamp, to include a local environment, as disclosed by Fransdonk, in order to provide geographic access criteria in DRM networks.

31. As to Claim 28, Steenkamp discloses the method of claim 26. Steenkamp does not explicitly disclose, however Fransdonk discloses wherein said client is not in a local environment of said server, and said local environment is a limited area defined relative to said server (Fransdonk; paragraphs 368-371).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the client/server, as disclosed by Steenkamp, to include a local environment, as disclosed by Fransdonk, in order to provide geographic access criteria in DRM networks.

32. As to Claim 31, Steenkamp discloses the method of claim 29. Steenkamp does not explicitly disclose, however Fransdonk discloses wherein said client is not in a local environment of said server, and said local environment is a limited area defined relative to said server (Fransdonk; paragraphs 368-371).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the client/server, as disclosed by Steenkamp, to include a local environment, as disclosed by Fransdonk, in order to provide geographic access criteria in DRM networks.

33. Claim 11, 12, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steenkamp, as applied to Claims 9 and 49 above, and further in view of U.S. Patent Application Publication No. 2007/0112948 to Uhlik (hereinafter "Uhlik").

34. As to Claim 11, Steenkamp discloses the method of claim 9. Steenkamp does not explicitly disclose, however Uhlik discloses wherein authorizing said client includes measuring the time between sending said local environment confirmation request and receiving a reply from said client in response to said local environment confirmation request (Uhlik; paragraphs 67, 68, 100, 122; round trip time).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorization, as disclosed by Steenkamp, to include round trip time, as disclosed by Uhlik, in order to facilitate improved service based on subscriber information.

35. As to Claim 12, Steenkamp discloses the method of claim 9. Steenkamp does not explicitly disclose, however Uhlik discloses wherein sending said local environment confirmation request includes pinging said client (Uhlik; paragraphs 67, 68, 100, 122; pinging).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorization, as disclosed by Steenkamp, to include pinging, as disclosed by Uhlik, in order to facilitate improved service based on subscriber information.

36. As to Claim 50, Steenkamp discloses the method of claim 49. Steenkamp does not explicitly disclose, however Uhlik discloses wherein authorizing said client includes measuring the time between sending said local environment confirmation request and receiving a reply from said client in response to said local environment confirmation request (Uhlik; paragraphs 67, 68, 100, 122; round trip time).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorization, as disclosed by Steenkamp, to include round trip time, as disclosed by Uhlik, in order to facilitate improved service based on subscriber information.

37. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steenkamp and Fransdonk, as applied to Claim 23 above, and further in view of Uhlik.

38. As to Claim 24, Steenkamp and Fransdonk disclose the method of claim 23. Steenkamp does not explicitly disclose, however Uhlik discloses wherein said authorization information is a reply to a ping request from said server (Uhlik; paragraphs 67, 68, 100, 122; ping).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorization, as disclosed by Steenkamp, to include pinging, as disclosed by Uhlik, in order to facilitate improved service based on subscriber information.

39. Claim 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steenkamp, as applied to Claims 1 and 18 above, and further in view of U.S. Patent No. 7,376,840 to McCann et al. (hereinafter "McCann").

40. As to Claim 13, Steenkamp discloses the method of claim 1. Steenkamp does not explicitly disclose, however McCann discloses further comprising checking a revocation list to determine whether said client is included in said revocation list; wherein said revocation list is stored on said server (McCann; column 7 lines 14-20, column 9 lines 3-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Steenkamp to include revocation lists, as disclosed by McCann, in order to enforce the revocation of authorization licenses in service networks.

41. As to Claim 25, Steenkamp discloses the method of claim 18. Steenkamp does not explicitly disclose, however McCann discloses further comprising checking a revocation list to determine whether said client is included in said revocation list; wherein said revocation list is stored on said client (McCann; column 7 lines 14-20, column 9 lines 3-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Steenkamp to include revocation lists, as disclosed by McCann, in order to enforce the revocation of authorization licenses in service networks.

42. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steenkamp, as applied to Claim 1 above, and further in view of U.S. Patent No. 7,203,966 to Abburi et al. (hereinafter "Abburi").

43. As to Claim 14, Steenkamp discloses the method of claim 1. Steenkamp does not explicitly disclose, however Abburi discloses confirming a device count of members in said hub network by comparing said device count with a member device limit; wherein said client will not be added as a member in said hub network if said device count is greater than or equal to said member device limit (Abburi; column 61 lines 44-67 and column 62 lines 1-35; device count/limit).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Steenkamp to include a device count and device member limit, as disclosed by Abburi, in order to limit license provisioning in a DRM network.

44. As to Claim 15, Steenkamp and Abburi disclose the method of claim 14. Abburi further discloses increasing said device count after adding said client as a member (Abburi; column 61 lines 44-67 and column 62 lines 1-35; device count/limit).

45. As to Claim 16, Steenkamp discloses the method of claim 1. Steenkamp does not explicitly disclose, however Abburi discloses comparing a device count of members in said hub network with a member device limit; and confirming said device count by contacting an external device registration server (Abburi; column 61 lines 44-67 and column 62 lines 1-35; device count/limit).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Steenkamp to include a device count and device member limit, as disclosed by Abburi, in order to limit license provisioning in a DRM network.

46. As to Claim 17, Steenkamp and Abburi disclose the method of claim 16. Abburi further discloses sending a device add request to said device registration server; and receiving a device add permission from said device registration server; wherein said device add request includes said device count (Abburi; column 61 lines 44-67 and column 62 lines 1-35; device count/limit).

Conclusion

47. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Krishnan whose telephone number is (571) 270-5009. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. K./
Examiner, Art Unit 2445

/Rupal D. Dharia/
Supervisory Patent Examiner, Art Unit
2400